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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Lee Doerksen

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7590

05/09/2006

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EXAMINER

DUNHAM, JASON B

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/625,999	<b>Applicant(s)</b> DOERKSEN ET AL.	
	<b>Examiner</b> Jason B. Dunham	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/19/03, 6/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 1-26 and 63-74 make reference to multiple statutory classes of invention. A claim that purports to be within multiple statutory classes is ambiguous and is properly rejected under U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the invention (see Ex Parte Lyell). The examiner notes that claims 1-26 and 63-74 are interpreted as method claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Bonneau (U.S. Patent No. 6,978,273).**

Referring to claim 1. Bonneau discloses a method for producing a customized catalog for a targeted recipient using a customized catalog publication system, wherein the system comprises a computer record, an offerings database comprising one or more candidate offerings, a set of products assets associated with each candidate offering, and a set of offering rules, and wherein the method comprises:

- Creating a customer profile from the customer record of the targeted recipient (Bonneau: column 4, lines 36-53);
- Applying the set of offering rules to the customer profile to select one or more selected offerings from the one or more candidate offerings in the offerings database (Bonneau: column 4, lines 36-53);
- Acquiring the set of product assets associated with each of the one or more selected offerings (Bonneau: abstract & column 4, lines 36-53); and
- Generating a customized catalog specification file for the targeted recipient using the set of product assets associated with each of the one or more selected offerings (Bonneau: column 3, lines 30-38 & column 4, line 54 – column 5, line 2).

Referring to claim 2. Bonneau further discloses a method comprising printing the customized catalog using the customized catalog specification file (Bonneau: column 3, lines 3-17).

Referring to claim 3. Bonneau further discloses a method wherein the set of product assets comprises one or more elements selected from the group consisting of text, graphics, and photographs (Bonneau: abstract & column 4, lines 36-53).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau (U.S. Patent No. 6,978,273) in view of Moore (U.S. Patent Application Publication No. 2002/0143603).**

Referring to claim 4. The combination of Bonneau and Moore discloses a system comprising a set of ranking rules and set of page allocation rules, and wherein generating a customized catalog specification file for the targeted recipient using the set of product assets associated with each of the one or more selected offerings comprises:

- Applying the set of ranking rules to each of the one or more selected offerings to determine its relevancy ranking (Bonneau: column 5, lines 18-33); and
- Applying the set of page allocation rules to allocate space within the customized catalog for each of the one or more selected offerings based on its relevancy ranking (Moore: abstract & figures 4-6).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Bonneau to have included applying a set of page allocation rules, as taught by Moore, in order to optimize the layout to increase the likelihood of a product being purchased (Moore: abstract).

Referring to claim 5. The combination of Bonneau and Moore further discloses a system comprising a set of layout rules and wherein the method further comprises applying the set of layout rules to the set of product assets associated with each of the one or more selected offerings to acquire one or more layout attributes for each of the

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one or more selected offerings consistent with the space allocated for that selected offerings (Moore: abstract & figures 4-6).

Referring to claim 6. The combination of Bonneau and Moore further discloses a method wherein the layout attributes are selected from the group consisting of a text, font, text size, graphic dimensions, photograph dimension, and photograph resolution (Bonneau: abstract & column 4, lines 36-53).

Referring to claim 7. The combination of Bonneau and Moore further discloses a method wherein the customized catalog comprises a plurality of pages, and wherein applying the set of page allocation rules to allocate space within the customized catalog for each of the one or more selected offerings based on its relevancy ranking comprises:

- Allocating one or more pages of the plurality of pages to a product section, the non-product section, and the pre-printed section (Moore: abstract & figures 4-6);
- Establishing in the product section the number of offerings per page (Moore: figure 6); and
- Assigning the product assets of each of the one or more selected offerings to one of the one or more product section pages in accordance with the number of offerings per page (Moore: figures 4-6).

Referring to claim 8. Claim 8 is rejected under the same rationale as set forth above.

Referring to claim 9. The combination of Bonneau and Moore further discloses a method wherein the system further comprises a set of signature rules and the method further comprises:

- Determining an actual page count of the customized catalog (Moore: paragraph 35);
- Determining if the actual page count comprises a whole signature (Moore: paragraph 35); and
- In the event the actual page count does not comprises a whole signature, applying the set of signature rules to force the actual page count to comprise a whole signature (Moore: figures 6-8).

Referring to claims 10-12. The combination of Bonneau and Moore further discloses a method wherein applying the set of signature rules to force the actual page count to an even signature comprises deleting or adding pages comprising filler pages (Moore: figures 6-8). The examiner notes that Moore discloses optimizing the layout of products in order to use all available space and produce a customized catalog with complete pages, see Moore, paragraph 61.

Referring to claim 13. The combination of Bonneau and Moore further discloses a method comprising applying a boost factor to at least one of the one or more candidate offerings prior to applying the set of offering rules to the customer profile (Moore: abstract). The examiner notes that Moore discloses optimizing the layout of the catalog in order to maximize profits, akin to “boosting” products due to manufacturer’s preferences.

Referring to claim 14. The combination of Bonneau and Moore further discloses a method for producing a customized catalog for a targeted recipient using a customized catalog publication system, wherein the system comprises a customer record, an offerings database comprising one or more candidate offerings, a set of product assets associated with each candidate offering, and a set of offerings rules as disclosed above and further comprising:

- Applying the set of catalog rules to the customer profile to make a first determination whether to produce the customized catalog for the targeted recipient (Moore: abstract); and
- In the event the customized catalog is produced for the targeted recipient, applying the set of catalog rules to the customer profile to make a second determination of the number of pages in the targeted recipient's customized catalog (Moore: abstract & figures 4-6).

Referring to claims 15-26. Claims 15-26 are rejected under the same rationale as set forth above.

Referring to claim 27. The combination of Bonneau and Moore further discloses a customized catalog publication system for producing a customized catalog, the system comprising:

- A customer record (Bonneau: column 3, lines 30-38);
- An offerings database comprising one or more candidate offerings (Bonneau: abstract);



- A set of product assets associated with each candidate offerings (Bonneau: abstract);
- A set of offering rules (Bonneau: abstract);
- A profiler adapted to create a customer profile from the customer record of a targeted recipient (Bonneau: column 4, lines 36-53); and
- A rules engine adapted to:
  - Apply the set of offering rules to the customer profile to select one or more selected offerings from the one or more candidate offerings (Bonneau: column 4, lines 36-53);
  - Acquire the set of product assets associated with each of the one or more selected offerings (Bonneau: abstract & column 4, lines 36-53); and
  - Generate a customized catalog specification file for the targeted recipient using the set of product assets associated with each of the one or more selected offerings (Bonneau: column 3, lines 30-38 & column 4, line 54 – column 5, line 2).

Referring to claim 28. Claim 28 is rejected under the same rationale as set forth above.

Referring to claim 29. The combination of Bonneau and Moore further discloses a customized catalog publication system, wherein the printing system comprises:

- A printer (Bonneau: column 3, lines 3-17); and
- A file translation system adapted to convert the specification file to a format compatible with the printer (Bonneau: column 3, lines 3-17).

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Referring to claims 30-32. The combination of Bonneau and Moore further disclose a customized catalog publication system wherein the printer is a web-fed printer, sheet-fed printer, or a toner, liquid ink, or ink-jet based printer (Moore: figure 1). The examiner notes that the type of printer is not given much patentable weight.

Referring to claims 33-62. Claims 33-62 are rejected under the same rationale as set forth above.

Referring to claim 63. The combination of Bonneau and Moore further discloses a method for producing a customized catalog for a targeted recipient using a customized catalog publication system, wherein the system comprises a customer record, an offerings database comprising one or more candidate offerings, a set of product assets associated with each candidate offering, and a set of offerings rules as disclosed above and further comprising:

- Assigning the targeted recipient to a customer group based on the customer profile of the targeted recipient and a profile of each member of the customer group (Bonneau: column 5, lines 39-60);
- Imputing attributes of the customer group to the customer profile of the targeted recipient to create a revised customer profile for the targeted recipient (Moore: abstract).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Bonneau to have included assigning attributes of the customer group to the profile of the targeted recipient, as

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taught by Moore, in order to produce a customized catalog to increase the likelihood of a product being purchased (Moore: abstract).

Referring to claims 64-74. Claims 64-74 are rejected under the same rationale as set forth above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Moore (U.S. Patent Application Publication No. 2003/0139979) discloses a system and method for producing a printed customized catalog.
- Tam (U.S. Patent Application Publication No. 2002/0184116) discloses a system and method for compiling product packages into a paper catalog.
- Batham (U.S. Patent Application Publication No. 2002/0082953) discloses a catalog building method and system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JBD  
Patent Examiner  
5/3/06

*Mark*  
*Primary Examiner*